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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,427	01/08/2001	Koichi Hayakawa	112857-247	5517

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BELL, BOYD & LLOYD, LLC  
P. O. BOX 1135  
CHICAGO, IL 60690-1135

EXAMINER
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SMITH, TRACI L

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/756,427

Applicant(s)

HAYAKAWA, KOICHI

ST

Examiner

Traci L Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner had several questions when determining the scope of the claims. The examiner was unable find answers to the questions when reviewing the disclosure. The following is a list of questions the examiner was unable to determine answers for through the disclosure.

3.
  1. What exactly is the "control-information"? Where did the control information initiate from?
  2. How is the communication connection established and what type of communication connection is it?
  3. How does purchase and/or service information get input and updated?
  4. When service information is updated how/where is it saved and stored?
  5. What is the external information processing apparatus in claim 16 and how does it differ from the apparatus being claimed in claim 1?

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11 and 13-21 and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,910,776 Black, June 8, 1999, filed on December 4, 1996.
5. As to claims 1,14-16 and 24-25 Black teaches a method, apparatus and medium for identifying and monitoring electronic equipment via a signal(Abstract(57) I.1-5)
6. - with means for acquiring product information and other data which can be changed or updated(C. 3 I. 13-15)
7. -with a means for storage of information(C.3 I. 16-17)
8. As to claims 2-3 and 17-18 Black teaches a method and apparatus of an information signal that travels via a any type of network.(C. 4 I. 8-11).
9. As to claim 4; Black teaches a method and apparatus of product information storage means.(C. 4 I. (34-36)
10. As to claims 5 and 19 Black teaches a method and apparatus of a identification reader.(C. 4 I. 7-9)
11. As to claims 6 Black teaches an method and apparatus information reading means from computer system( C. 4 I. 49-52)
12. As to claims 7 and 20 Black teaches a method and apparatus with a monitor displaying means for displaying information. (Fig. 5 Ref. 61).

13. As to claim 8 Black teaches means for updating and inputting information.(C. 4 l. 31-33).

14. As to claims 9 and 21 Black teaches a method and apparatus of having a connection for transmitting information.(C. 3 l. 63-64)

15. As to claims 10-11 Black teaches a method and apparatus of Read Only Memory. (C. 3 l. 17-18)

16. As to claims 13 and 23 Black teaches a method and apparatus of equipment information and maintenance schedule(C. 4 l. 22-30).

***Claim Rejections - 35 USC § 103***

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,910,776 Black, June 8, 1999, filed on December 4, 1996 as applied to claims 1-11 and 13-21 and 23-25 above, and further in view of US Patent 5,745,036 Clare, April 28, 1998.

19. As to claim 12 and 22 Black teaches a method and apparatus for identifying and monitoring electronic equipment via a signal. However, Black fails to teach a purchase

Art Unit: 3629

information that comprises specific information regarding the electronic equipment. Clare teaches an electronic article security system that monitors articles and contains purchase information such as store number and date of purchase.(Fig. 4 Ref 36.) It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Clare with Black as they both are RFID apparatuses used for monitoring electronic equipment.

### ***Conclusion***

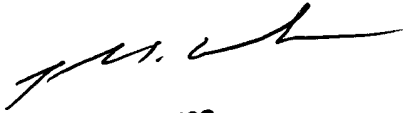
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. European Patent EP 1, 102, 268 A2; Gayama et al ; November 15, 1999. An AV information processing apparatus to be used with a computer program. Non-patent literature news article ; **Business Wire** ; *'Warrantech introduces several new programs'*; February 9, 1993. The article discusses Warrantechs new services for tracking appliance and electronic warranties. Also included with the article is information taken from their webpage via the wayback machine at [www.warrantech.com](http://www.warrantech.com); any linkage November 14, 1999.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600